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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

CYPR-CD00232

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on 10/09/07

Signature

Typed or printed
name

DONNA PETFORD

Application Number

10/033,027

Filed

10/22/01

First Named Inventor

SNYDER

Art Unit

2183

Examiner

PAN, D.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

attorney or agent of record.

Registration number 35,295☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Signature

ANTHONY C. MURABITO

Typed or printed name

(408) 938-9061

Telephone number

10/09/07

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐

*Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Snyder

Serial: 10/033,027

Group Art Unit: 2183

Filed: 10/22/2001

Examiner: Daniel H. Pan

For: PROGRAMMABLE MICROCONTROLLER ARCHITECTURE

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and

EXAMINER INTERVIEW SUMMARY

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PO Box 1450

Alexandria, VA 22313-1450

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ARGUMENTS

Appellants respectfully assert that there is no motivation to combine Tzori in view of Insenser, as proposed by the rejection. Therefore, the cited combination does not render obvious the claims. The rejection proposes the modification in order to “includ(e) the analog blocks as claimed.” Herein, the rejection concedes that the rejection was improperly guided by hindsight in view of the claims of the present application.

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Per *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991), “[a] proper analysis under § 103 requires, *inter alia*, consideration of... whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed composition or device, or carry out the claimed process.” Regardless of the type of disclosure, the prior art must provide some motivation or suggestion to one of ordinary skill in the art to make the claimed invention in order to support a conclusion of obviousness.

As there is no suggestion in the art to make the proposed modification, Appellants respectfully assert that the rejection relies upon impermissible hindsight to forge a combination of disparate references guided only by the disclosure and claims of the present application. Consequently, the rejection fails to establish *prima facie* obviousness.

Further, the proposed addition of analog blocks clearly changes the digital principle of operation of the primary reference. Per *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959), “if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.” As the proposed modification changes the principle of operation of the primary reference, the rejection fails to establish *prima facie* obviousness.

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known, an IC socket is a mechanical device that may accept, remove or replace an IC. Without a mated IC, the IC socket has no logic or analog function.

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The rejection alleges that Tzori “pod 32” suggests the claimed bus and recited couplings of said bus. Appellants traverse. As understood by Appellants, “pod 32” is a printed circuit board assembly comprising at least six integrated circuits and other components, including a socket for another IC, as described above and in Figure 1. Appellants respectfully assert that one of ordinary skill in the art would not understand “pod 32” as the recited “bus.”

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The rejection alleges that “circuit board trace 42... (is) dynamically configurable and programmable.” Appellants traverse. Tzori teaches “[a]ll IC pin-receptacles 38 included in the IC socket 34 connect by individual printed circuit board traces 42 to the configurable-logic IC 36a or 36b” (column 8, lines 30-33). Thus, Tzori teaches traces 42 are static and non changing, connecting pins of the IC socket to other ICs. As the rejection’s interpretation of the cited art is demonstrably incorrect, the alleged teachings are not present, do not suggest the claimed limitations, and the rejection fails to establish *prima facie* obviousness.

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configuration with a single register write operation, as claimed. In addition, Tzori teaches, “logic-configuration library 86 which stores a configuration-data file that contains the logic-configuration data loaded into the configurable-logic ICs 36a and 36b” (column 10 lines 33-44). The taught “logic-configuration library 86” and “configuration-data file” suggest that configuration requires more than a “single register write operation,” in contrast to the instant limitation. As the rejection’s interpretation of the cited art is not supported by the cited art, the alleged teachings are not present, do not suggest the claimed limitations and the rejection fails to establish *prima facie* obviousness.

Appellants respectfully assert that van der Wal is non-analogous art per *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992). Per *In re Clay*, a reference must “(commend) itself to an inventor’s attention in considering his problem.” Appellants respectfully assert that van der Wal is directed to a “real time modular video processing system” (Abstract). Appellants do not find the video processing systems taught by van der Wal to commend van der Wal to Appellants in consideration of Appellants’ problem. For example, the claims of the present invention are not directed to video processing.

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In summary, Appellants respectfully submit that the Examiner’s rejections of the Claims are improper as key limitations needed for proper *prima facie* rejections of Appellants’ Claims are not met by the cited references as outlined above. Key limitations of independent Claims 1, 11, 17, 35, 37, 42, 51, 52 and 58 (from which Claims 2-10, 13-16, 18, 20, 21, 23-34, 36, 38-41, 43-49, 57 and 59 depend) are not taught or suggested by the cited art. In addition, the proposed combinations of art are improper, as outlined above. Appellants respectfully submit that the rejections of Claims 1-11, 12-18, 20-21, 23-49, 51-52 and 57-59 are improper and should be reversed.

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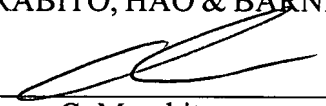
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MURABITO, HAO & BARNES LLP

Date: Oct 9, 2007



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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Snyder

Serial: 10/033,027

Group Art Unit: 2183

Filed: 10/22/2001

Examiner: Daniel H. Pan

For: PROGRAMMABLE MICROCONTROLLER ARCHITECTURE

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CYPR-CD00232/ACM/NAO

Examiner: Pan, D. H.

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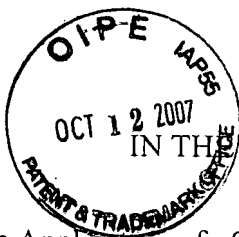
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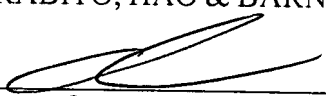
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MURABITO, HAO & BARNES LLP

Date:

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